

REMARKS

Claims 10-25 are pending in the present Application. Claims 10, 17, 18, and 25 have been amended, claims 1-9, 15, and 23 have been cancelled, and claims 26-29 have been added, leaving claims 10-14, 16-22, and 24-29 for consideration upon entry of the present response.

Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Amendments and New Claims

Support for the amendment to claim 10 is found in claim 15, which has been cancelled.

Claim 18 has been amended to delete redundancies.

Claims 17 and 25 have been amended to delete individual species (biphenyl). Further, in Example, 5 fluorobiphenyl and cyclohexylbenzene were used, and in Example 6, biphenyl and isopropylbenzene were used.

Support for new claims 26-29 can be found at least in claims 10, 15, and 16.

Claim Rejections Under 35 U.S.C. § 112

Claims 10-25 stand rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner asserts that “an electrolyte compound” as recited in claims 10 and 18 is unclear.

Claim 10 has been amended to recite “an electrolyte solvent,” supported at least in the specification on page 15, lines 1-10. Also, because claim 18 depends from claim 10, and thus includes all of the limitations of claim 10, the repeated limitations in claim 18 have been deleted for clarity.

Accordingly, Applicants respectfully traverse this rejection based on the above amendments to claims 10 and 18. Reconsideration and withdrawal of the rejection of claims 10-25 under 35 U.S.C. § 112 are respectfully requested.

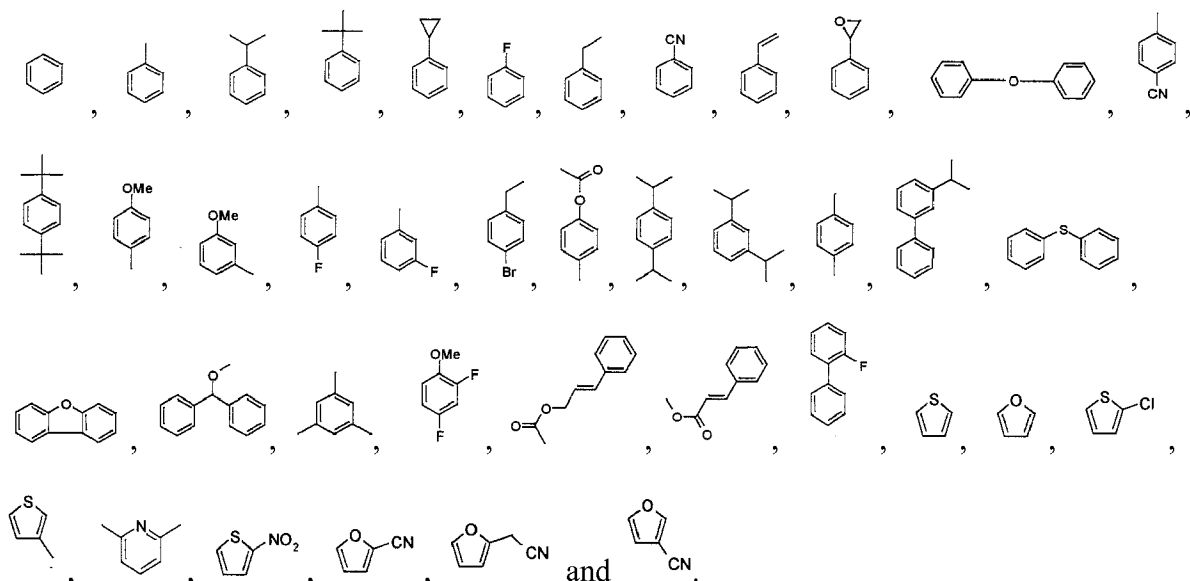
Claim Rejections Under 35 U.S.C. § 102(b)/(e)/§ 103(a)

Claims 10-25 stand rejected under 35 U.S.C. § 102(b)/(e) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a), as being allegedly unpatentable over Watanabe et al. (WO 02/31904/US 2003/0118912, hereinafter “Wantanabe”) as stated on pages 3-4 of the Office Action dated March 25, 2010. Citations to Wantanabe herein are to the U.S. Patent Publication, U.S. 2003/0118912. The Examiner states that Wantanabe teaches all of the elements of claims 10-25, including an electrolyte comprising 0.01-1.0 wt% biphenyl and 1.0-5.0 wt% cyclohexylbenzene. (Office action dated 03/25/2010, p. 3) Applicants respectfully traverse this rejection for at least the following reasons.

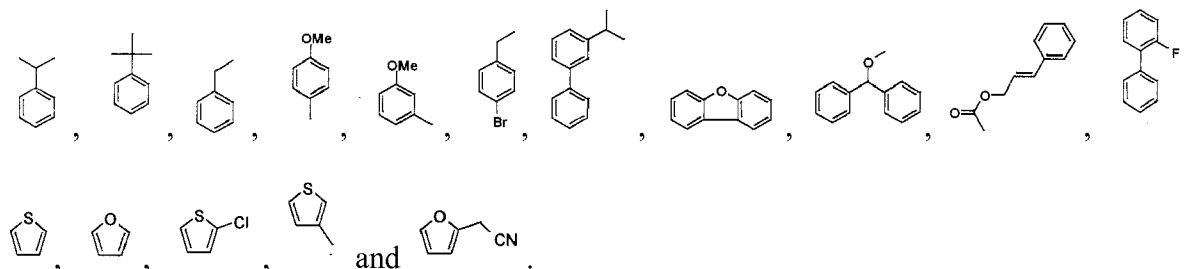
To anticipate a claim, a reference must disclose each and every limitation of the claim. *Lewmar Marine v. Varient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Moreover, the single source must disclose all of the claimed elements “arranged as in the claim.” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1274 (Fed. Cir. 1984). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

For an obviousness rejection to be proper, the Examiner is expected to meet the burden of establishing why the differences between the prior art and that claimed would have been obvious. (MPEP 2141(III)) “A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). To find obviousness, the Examiner must “identify a reason that would have prompted a person of ordinary skill in the art in the relevant field to combine the elements in the way the claimed new invention does.” *Id.*

Amended claim 10 recites a nonaqueous electrolyte comprising a first additive and a second additive, wherein the first additive is selected from the group consisting of



Also, new claim 26 recites a nonaqueous electrolyte comprising a first additive and a second additive, wherein the second additive is selected from the group consisting of



Wantanabe, in contrast, discloses addition of at least two organic compounds selected from o-terphenyl, triphenylene, cyclohexylbenzene and biphenyl. Wantanabe does not disclose or suggest a nonaqueous electrolyte wherein the first additive is selected from the claimed group, which does not contain either of biphenyl or cyclohexylbenzene. Also, Wantanabe also does not disclose or suggest a nonaqueous electrolyte wherein the second additive is selected from the claimed group, again which does not contain either of biphenyl or cyclohexylbenzene.

Furthermore, the Applicants respectfully assert that the synergistic results disclosed by the Applicants further support the patentability of the instant claims. For example, the Applicants disclose in Examples 5 to 11 the results of the additives fluorobiphenyl, isopropylbenzene, vinylbenzene, toluene, t-butylbenzene, mesitylene, bromoethylbenzene, thiophene, and furan. (Specification, p. 22, Table 4) For at least the reason that Wantanabe does not teach or suggest fluorobiphenyl, isopropylbenzene, vinylbenzene, toluene, t-

butylbenzene, mesitylene, bromoethylbenzene, thiophene, or furan, one of ordinary skill in the art would not have been prompted to consider adding such compounds to a nonaqueous electrolyte, let alone expect the unexpected improvement in overcharge performance disclosed by the Applicants.

Accordingly, for at least these reasons, Wantanabe does not anticipate or render obvious the subject matter of independent claims 1 or 26. Claims 11-14, 16-22, and 24-25 depend from claim 10, and thus include the allowable elements of claim 10. Also, new claims 27-29 depend from new independent claim 26, and thus include the allowable elements of claim 26. Thus the dependent claims are patentable over the cited references for at least the reasons given above for independent claim 10 and 26.

Accordingly, reconsideration, withdrawal of the rejection of claims 10-25 under 35 U.S.C. § 102(b)/(e), or in the alternative under 35 U.S.C. § 103(a), and allowance of the instant claims are respectfully requested.

Conclusion

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and withdrawal of the objection(s) and rejection(s) and allowance of the case are respectfully requested.

Applicants hereby petition for any necessary extension of time required under 37 C.F.R. 1.136(a) or 1.136(b) or any other necessary fees(s), which may be required for entry and consideration of the present Reply.

Application No.: 10/588,481
Response dated: June 24, 2010

If there are any additional charges due with respect to this Amendment or otherwise,
please charge them to Deposit Account No. 06-1130 maintained by Applicants' Attorneys.

Respectfully submitted,

CANTOR COLBURN LLP
Applicants' Attorneys

Date: June 24, 2010

20 Church Street
22nd Floor
Hartford, CT 06103-3207
Telephone (860) 286-2929
Facsimile (860) 286-0115
Customer No.: 23413

By: ___/Grant M. Ehrlich/___
Leah M. Reimer, Ph.D.
Registration No. 39,341

Grant M. Ehrlich, Ph.D.
Registration No. 56,185